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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/768,722	01/30/2004	Pamela S. Greene	005127.00218	5118

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BANNER & WITCOFF, LTD.
28 STATE STREET
28th FLOOR
BOSTON, MA 02109-9601

EXAMINER	
KAVANAUGH, JOHN T	

ART UNIT	PAPER NUMBER
3728	

DATE MAILED: 09/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/768,722	GREENE ET AL.	
	Examiner	Art Unit	
	Ted Kavanaugh	3728	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *06 September 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-45* is/are pending in the application.

4a) Of the above claim(s) *7,12-26,31-33,39 and 44* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-6,8-11,27-30,34-38,40-43 and 45* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *3-15-04&5-16-05*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of species I (figs. 1-3) in the reply filed on Sept. 6, 2005 is acknowledged. The traversal is on the ground(s) that it would not be a serious burden to examine these additional species. This is not found persuasive because while the searches may overlap the search would be burdensome and longer because the examiner would need to search for six distinct inventions or variations. Furthermore, the search is only part of the examination process, the MPEP 803 states "If the search and examination of an entire application ..." (underline added) can be made without serious burden". The examination of the application would be burdensome because the examiner would be required to apply art and rejections to six distinct and different species of invention.

The requirement is still deemed proper and is therefore made FINAL.

2. Claims 7,12-26,31-33,39 and 44 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim.

Specification

3. The disclosure is objected to because of the following informalities: In paragraph #32, line 7, "23" should be "24". In paragraph #33, lines 2 and 3, "40" should be "46".

Appropriate correction is required.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 1-6,8-9,11,27,29,38,40-43,45 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 4276671 (Melton) in view of US 5676641 (Arensdorf et al) and [US 2932829 (Corbin) and/or US 3013564 (Levey).

Melton teaches an article of footwear (sock) comprising an outsole (13) and an upper (11) as claimed except for a wrap and the upper having a 1st and 2nd toe pocket. Arensdorf teaches applying a wrap (strap members with hook and loop ends) around the midfoot and heel portion of the sock. It would have been obvious to provide the article of footwear of Melton with a wrap, as taught by Arensdorf, to provide ankle support to the wearer. One straps of Arensdorf serve as the strap extending over the wrap across the midfoot portion of the upper and is attached by hook and loop fastener. The straps are attached on the medial side and the lateral side extends to the other side. Corbin and Levey teaches a sock having a first pocket and a second pocket to provide a more comfortable sock. It would have been obvious to provide the sock upper of the footwear taught above with a first and second pocket, as taught by Corbin and/or Levey, to provide a more comfortable article of footwear. Regarding the upper formed of knit textile and spandex blend, it would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the sock upper as taught above out of knit textile and spandex blend, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416. . Regarding the outsole formed out of neoprene foam, it would have been obvious to one having ordinary skill in the art at the time the invention was made to

construct the outsole out of neoprene foam, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

6. Claims 1-6,8-9,11,27,29,38,40-43,45 are rejected under 35 U.S.C. 103(a) as being unpatentable over US D288,742 (Caretti) in view of US D385,102 (Avar) and US 4461288 (Curtis).

Caretti teaches an article of footwear comprising an outsole and upper (11) as claimed except for a wrap. Avar teaches a wrap and a strap with hook and loop fastener (see all the figures) as claimed. Curtis teaches a wrap (25), like Avar, and teaches this wrap provides stabilizing, see the abstract. It would have been obvious to provide the footwear of Caretti, with a wrap and strap as taught by Avar, in view of the teachings of Avar and Curtis, to provide more stability to the wearer.

Regarding the upper formed of knit textile and spandex blend, it would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the upper as taught above out of knit textile and spandex blend, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416. .
Regarding the outsole formed out of neoprene foam, it would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the outsole out of neoprene foam, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

7. Claim 10,28,30,34-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over the rejections as applied to the claims above, and further in view of US 5689903 (Aumann).

Aumann teaches it is old in the art to provide a polyurethane coating inside and outside the footwear to provide a waterproof feature; see the background of the invention. It would have been obvious to provide the footwear as taught above with a polyurethane coating, as taught by Aumann, to provide a waterproof footwear.

8. Claim 30 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over the rejections as applied to the claims above, and further in view of US 5526584 (Bleimhofer et al).

Bleimhofer teaches applying a waterproof coating (tape 25,27,29) over the stitching. It would have been obvious to provide the footwear as taught above with a waterproof coating over the stitching, as taught by Bleimhofer, to provide a more waterproof footwear.

Conclusion

9. Applicant is duly reminded that a complete response must satisfy the requirements of 37 C.F. R. 1.111, including:

-"The reply must present arguments pointing out the *specific* distinctions believed to render the claims, including any newly presented claims, patentable over any applied references."

--"A general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references does not comply with the requirements of this section."

-Moreover, "The prompt development of a clear issue requires that the replies of the applicant meet the objections to and rejections of the claims. Applicant should also specifically point out the support for any amendments made to the disclosure. See MPEP 2163.06" MPEP 714.02. The "disclosure" includes the claims, the specification and the drawings.

10. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see **http://pair-direct.uspto.gov**. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). Other useful information can be obtained at the PTO Home Page at www.uspto.gov.

In order to avoid potential delays, Technology Center 3700 is encouraging FAXing of responses to Office Actions directly into the Center at *(571) 273-8300* **(FORMAL FAXES ONLY)**. Please identify Examiner Ted Kavanaugh of Art Unit 3728 at the top of your cover sheet.

Any inquiry concerning the MERITS of this examination from the examiner should be directed to Ted Kavanaugh whose telephone number is (571) 272-4556. The examiner can normally be reached from 6AM - 4PM.

Ted Kavanaugh
Primary Examiner
Art Unit 3728

TK
September 27, 2005